

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Glen Friedman et al.

Confirmation No.: 4318

Application No.: 09/997,713

Filed: November 29, 2001

For: METHOD AND APPARATUS FOR VIRTUAL EDITING OF  
MULTIMEDIA PRESENTATIONS

Atty. Docket No.: 007287.00014

Group Art Unit: 2179

Examiner: Bautista, Xiomara L.

**APPEAL BRIEF**

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Sir:

This is an Appeal Brief filed in support of Appellants' April 26, 2008, Notice of Appeal and Pre-Appeal Brief Request for Review. Appeal is taken from the Final Office Action mailed November 28, 2007 (hereafter, "Final Office Action"), and the Notice of Panel Decision from Pre-Appeal Brief Review mailed May 28, 2008.

Please charge any fees to Deposit Account No. 19-0733. In addition, any extensions of time necessary for acceptance or entry of this paper are hereby requested.

**REAL PARTY IN INTEREST**

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is JLB Ventures, LLC.

**RELATED APPEALS AND INTERFERENCES**

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

**STATUS OF CLAIMS**

37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-7, 18, and 20 are rejected and presently appealed.

Claims 8-17 and 19 have been canceled.

**STATUS OF AMENDMENTS**

37 C.F.R. § 41.37(c)(1)(iv)

No amendments have been made subsequent to final rejection.

**SUMMARY OF CLAIMED SUBJECT MATTER**

37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various embodiments in the specification text and/or drawings to explain the claimed invention, Appellants do not intend to limit the claims to those embodiments; all references to the specification and drawings are illustrative unless otherwise explicitly stated. Appellants refer to the patent application publication, U.S. Patent Pub. No. 2002/0087595, for the cited support.

Independent claim 1 is directed to a method comprising automatically identifying a plurality of desired portions of a multimedia presentation by user's equipment. U.S. Patent Pub. No. 2002/0087595, paragraphs [0015], [0020], [0026] and Fig. 2. The method further comprises automatically creating, at the user's equipment, an annotation file for the multimedia presentation, the annotation file containing a first pointer corresponding to a first desired portion of the plurality of desired portions and a second pointer corresponding to a second desired portion of the plurality of desired portions, wherein the first desired portion and the second desired portion is separated in the multimedia presentation by an intervening portion. *Id.*,

paragraphs [0015], [0018], [0020], [0026], [0032], [0034], and Figs. 2-3. The method further comprises using the plurality of pointers to automatically present only the plurality of desired portions of the multimedia presentation without presenting any other portion of the multimedia presentation including the intervening portion, wherein the second desired portion is displayed automatically after the first desired portion without user interaction. *Id.*, paragraphs [0032] and [0034] and Fig. 3.

Independent claim 6 is directed to a method comprising broadcasting an event to a first location. *Id.*, paragraph [0025] and Fig. 2 (satellite receiver dish 210/set-top box 211). The method further comprises simultaneously identifying a plurality of desired portions of the event at a location remote from said first location. *Id.*, paragraph [0022], paragraph [0028] and Fig. 2 (server 243/workstation 242). The method further comprises creating an annotation file for the event substantially simultaneously to said broadcasting, the annotation file containing a first pointer corresponding to a first desired portion of the plurality of desired portions and a second pointer corresponding to a second desired portion of the plurality of desired portions. *Id.*, paragraph [0023], paragraph [0028] and Fig. 2 (server 243/workstation 242), paragraphs [0032] and [0034]. The method further comprises transmitting, from the location remote from said first location, to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event, the annotation file configured to automatically display only the plurality of desired portions of the event without displaying the annotations and without displaying any other portion of the event, the second desired portion being automatically displayed after the first desired portion without user interaction. *Id.*, paragraphs [0027]-[0029] and Fig. 2 (back-channel connection), paragraphs [0032] and [0034].

Independent claim 18 is directed to a system comprising an editor configured to automatically create an annotation file without user prompt or intervention, the annotation file containing a first pointer and a second pointer corresponding to a first desired portion and a second desired portion, respectively, of a multimedia presentation based on at least one predefined set of criterion or criteria. *Id.*, paragraph [0015] and Fig. 1 (operation 110), paragraphs [0032] and [0034]. The system further comprises a first transmission medium to transmit the multimedia presentation to a multimedia viewing system. *Id.*, paragraphs [0024]-[0026] and Fig. 2. The system further comprises a second transmission medium to transmit the

annotation file to the multimedia viewing system such that the multimedia viewing system automatically displays only the first and second desired portions of the multimedia presentation without displaying the annotations, wherein the second desired portion is displayed automatically after the first desired portion without user interaction. *Id.*, paragraphs [0024] and [0027]-[0029] and Fig. 2, paragraphs [0032] and [0034].

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

37 C.F.R. § 41.37(c)(1)(vi)

- Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,546,405 to Gupta *et al.* (“Gupta”), in view of U.S. Patent No. 6,366,296 to Boreczky *et al.* (“Boreczky”), and in further view of U.S. Patent No. 5,884,256 to Bennett *et al.* (“Bennett”).
- Claims 6, 7, 18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta, in view of Boreczky and Bennett, and in further view of U.S. Patent No. 5,907,322 to Kelly *et al.* (“Kelly”).

### **ARGUMENT**

37 C.F.R. § 41.37(c)(1)(vii)

#### **A. Rejection of Claims 1-5 over Gupta, in view of Boreczky and Bennett**

##### **1. Independent Claim 1**

Independent claim 1 recites, among other features, “using the plurality of pointers to automatically present only the plurality of desired portions of the multimedia presentation without presenting any other portion of the multimedia presentation including the intervening portion, *wherein the second desired portion is displayed automatically after the first desired portion without user interaction.*” (Emphasis added).

As discussed in Applicants’ Pre-Appeal Brief Request For Review, dated April 26, 2008, at page 2, and as conceded by the Office<sup>1</sup>, Gupta and Boreczky fail to teach or suggest the above-noted features related to displaying automatically a second desired portion after a first desired

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<sup>1</sup> See the Final Office Action at page 7.

portion without user intervention. The Office relies on Bennett to allegedly cure the deficiencies of Gupta and Boreczky. However, as noted in Applicants' Pre-Appeal Brief Request For Review at page 2, Bennett fails to cure the deficiencies of Gupta and Boreczky in this respect; rather, Bennett is deficient as discussed below.

Bennett is directed to a networked stenographic system with real-time speech to text conversion for down-line display and annotation. *See* Bennett at Title and Abstract. The Final Office Action at page 7 asserts that the pointers disclosed in Bennett at col. 13, lines 30-56, and col. 18, lines 25-64 serve as automatic markings of portions that can be used to display recorded material (e.g., the alleged second desired portion as recited in claim 1). Furthermore, the Final Office Action at page 7 contends that Bennett at col. 25, line 37 – col. 26, line 33 discloses that the desired (marked) portions can be provided automatically without user interaction.

As described in Bennett at col. 18, lines 25-32 and Fig. 6b, a “mark” key 273 associated with a keyboard 253 can be used to mark any question-&-answer (Q & A) for later reference. Bennett at col. 18, lines 33-51 continues that a user (e.g., an examining attorney) can press a quick-up key 275 or a quick-down key 277, wherein successive strokes serve to page previously marked Q & A's. Even assuming (without admitting) that the use of mark key 273 in conjunction with quick-up key 275 and/or quick-down key 277 may appropriately be analogized to using a plurality of pointers to automatically present only a plurality of desired portions of a multimedia presentation without presenting any other portion of the multimedia presentation including an intervening portion as recited in claim 1, the utilization still requires the user/examining attorney to manually interact with at least one of quick-up key 275 and quick-down key 277 to obtain the desired Q & A's (e.g., the alleged desired portions of the multimedia presentation as recited in claim 1). Bennett at col. 18, lines 52-64 discloses alternatives using a “number” key 278, a scan-up key 279, and a scan-down key 281. These alternatives require user interaction, and thus, fail to teach or suggest the above-noted features for similar reasons. Thus, Bennett clearly requires user interaction to move between marked portions.

Claim 1 is allowable over the applied references for at least the foregoing reasons (notwithstanding whether any combination of the applied references is proper).

## **2. Dependent Claims 2-5**

Claims 2-5 depend from claim 1 and are allowable over the applied references for at least the same reasons as claim 1.

## **B. Rejection of Claims 6, 7, 18, and 20 over Gupta, Boreczky, Bennett and Kelly**

### **1. Independent Claim 6**

Independent claim 6 recites, among other features, “the second desired portion being automatically displayed after the first desired portion without user interaction.” This feature is similar to features described above with respect to claim 1. As such, claim 6 is allowable over Gupta, Boreczky and Bennett for reasons substantially similar to those described above with respect to claim 1. Notwithstanding whether Kelly is properly combinable with any of Gupta, Boreczky, and Bennett, Kelly fails to cure the above noted deficiencies of Gupta, Boreczky, and Bennett with respect to claim 6. As such, claim 6 is allowable.

Furthermore, claim 6 recites “transmitting, *from* the location remote from said first location, to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event . . .” As discussed in Applicants’ Pre-Appeal Brief Request For Review at page 3, Kelly fails to disclose such features. Instead, Kelly merely describes transmitting an activity table *to* an on-line database (i.e., the alleged location remote from the first location). *See* Final Office Action at page 10 (citing Kelly at col. 1, lines 54-67). Gupta, Boreczky, and Bennett (alone or in combination) fail to remedy the deficiencies of Kelly. As such, and notwithstanding whether any combination of the applied references is proper, claim 6 is allowable over the applied references for at least these additional reasons.

### **2. Dependent Claim 7**

Claim 7 depends from claim 6 and is allowable over the applied references for at least the same reasons as claim 6.

### **3. Independent Claim 18**

Independent claim 18 recites, among other features, “a second transmission medium to transmit the annotation file to the multimedia viewing system such that the multimedia viewing

system automatically displays only the first and second desired portions of the multimedia presentation without displaying the annotations, wherein the second desired portion is displayed automatically after the first desired portion without user interaction.” These features are similar to features described above with respect to claim 6. As such, claim 18 is allowable over the applied references for at least reasons substantially similar to those described above with respect to claim 6.

**4. Dependent Claim 20**

Claim 20 depends from claim 18 and is allowable over the applied references for at least the same reasons as claim 18.

**CONCLUSION**

For all of the foregoing reasons, Appellant respectfully submits that the final rejection of claims 1-7, 18, and 20 is improper and should be reversed.

Respectfully submitted,  
BANNER & WITCOFF, LTD.

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**CLAIMS APPENDIX**  
37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

Claim 1: A method comprising:

automatically identifying a plurality of desired portions of a multimedia presentation by user's equipment;

automatically creating, at the user's equipment, an annotation file for the multimedia presentation, the annotation file containing a first pointer corresponding to a first desired portion of the plurality of desired portions and a second pointer corresponding to a second desired portion of the plurality of desired portions, wherein the first desired portion and the second desired portion is separated in the multimedia presentation by an intervening portion; and

using the plurality of pointers to automatically present only the plurality of desired portions of the multimedia presentation without presenting any other portion of the multimedia presentation including the intervening portion, wherein the second desired portion is displayed automatically after the first desired portion without user interaction.

Claim 2: The method of claim 1 further comprising:

creating a recorded program file of the multimedia presentation;  
playing the recorded program file on a viewing system; and  
accessing the annotation file such that only the plurality of desired portions of the multimedia presentation is displayed by the viewing system automatically.

Claim 3: The method of claim 1, wherein the automatic identification of the plurality of desired portions includes applying a predetermined set of criteria to the multimedia presentation.

Claim 4: The method of claim 1, wherein the predetermined set of criteria is based upon a preference of an individual viewer.



Claim 5: The method for applying an annotation file of claim 1, wherein the annotation file further contains: information related to the plurality of desired portions of the multimedia presentation.

Claim 6: A method comprising:

- broadcasting an event to a first location;
- simultaneously identifying a plurality of desired portions of the event at a location remote from said first location;

- creating an annotation file for the event substantially simultaneously to said broadcasting, the annotation file containing a first pointer corresponding to a first desired portion of the plurality of desired portions and a second pointer corresponding to a second desired portion of the plurality of desired portions; and

- transmitting, from the location remote from said first location, to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event, the annotation file configured to automatically display only the plurality of desired portions of the event without displaying the annotations and without displaying any other portion of the event, the second desired portion being automatically displayed after the first desired portion without user interaction.

Claim 7: The method of claim 6, wherein the annotation file is transmitted subsequent to the event.

Claim 18: A system comprising:

- an editor configured to automatically create an annotation file without user prompt or intervention, the annotation file containing a first pointer and a second pointer corresponding to a first desired portion and a second desired portion, respectively, of a multimedia presentation based on at least one predefined set of criterion or criteria;

- a first transmission medium to transmit the multimedia presentation to a multimedia viewing system; and

a second transmission medium to transmit the annotation file to the multimedia viewing system such that the multimedia viewing system automatically displays only the first and second desired portions of the multimedia presentation without displaying the annotations, wherein the second desired portion is displayed automatically after the first desired portion without user interaction.

Claim 20: The system of claim 18, wherein the annotation file further contains: information related to at least one of the first and second desired portions of the multimedia presentation.

**EVIDENCE APPENDIX**  
37 C.F.R. § 41.37(c)(1)(ix)

NONE.

**RELATED PROCEEDINGS APPENDIX**  
37 C.F.R. § 41.37(c)(1)(x)

NONE.